

Appl. No. : 09/457,207
Filed : December 7, 1999

REMARKS

Claims 1, 3-5, 8 and 11-27 are pending in this application. In the January 9, 2004 Office Action, the Examiner objected to Claims 17-18 and 20-21 as being dependent upon a rejected base claim but indicated such claims would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim. The Examiner also objected to independent Claims 1, 5, 8 and 11, and their corresponding dependent claims, because of informalities. In addition, the Examiner rejected Claims 1, 3-5, 8, 11-16, 19 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,560,557 ("the Carnahan patent").

In response to the Office Action, Applicant has amended Claims 1, 5, 8 and 11 and has added new Claims 24-27. Therefore, Applicant respectfully requests allowance of Claims 1, 3-5, 8 and 11-27

Allowable Subject Matter—Claims 17-18 and 20-21

Applicant thanks the Examiner for the indication of allowable subject matter in Claims 17-18 and 20-21. Applicant has added new independent Claims 24-26 and new dependent Claim 27, which include the limitations of Claims 17-18 and 20-21, respectively, and all the limitations of the corresponding base claims and any intervening claims. Applicant has also made changes to the preambles of new independent Claims 24-26 in view of the Examiner's informality objections, which are discussed in more detail below. Accordingly, Applicant respectfully submits that new Claims 24-27 are in condition for allowance.

Claim Objections as to Informalities

The Examiner objected to independent Claims 1, 5, 8 and 11, and their corresponding dependent claims, because of informalities. With respect to Claim 1, the Examiner stated that it was not clear if "the modem" as recited in lines 8, 9, 14 and 15 referred to the term "a modem" recited in the preamble or the term "a modem" as recited in line 5. Similar objections were made with respect to the other claims. Therefore, Applicant has amended the preambles of Claims 1, 5, 8 and 11 so as to clarify the claims. Applicant respectfully requests the Examiner to withdraw the objections as to informalities.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 1, 3-5, 8, 11-16, 19 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Carnahan.

Focusing on amended independent Claim 1, in one embodiment of Applicant's invention a device is disclosed for testing the operation of a modem. The device comprises: (1) a first communication port configured to be coupled to a modem in a computer to form a primary communication link and (2) a second communication port configured to be coupled to the computer to form a secondary communication link that bypasses the modem. The recited primary communication link and secondary communication link provide separate paths to the computer.

Carnahan does not teach a testing device having the structure recited in amended Claim 1. In particular, Carnahan does not disclose a modem testing device that is configured to: (1) couple to a modem of a computer to form a first communication link and (2) couple to the computer to form a second communication link that provides a separate path to the computer and that also bypasses the modem. Carnahan also does not appear to disclose the testing of a modem.

Rather, in Figure 1, which was referenced by the Examiner, Carnahan discloses "five different configurations for remote demonstration and training" (see col. 3 at lines 3-4). It appears that each configuration is disclosed as having a test instrument connected to a client computer through a single communication link (see col. 3 at line 62 through col. 4 at line 25). In addition, all the disclosed communication links between the test instruments and the client computer (24) include the path from a LAN port (23) to the computer (24). Thus, Carnahan does not appear to disclose two communication links that provide separate paths to a computer.

Because the reference cited by the Examiner does not disclose, teach or suggest a testing device as recited in amended Claim 1, Applicant asserts that Claim 1 is not obvious in view of Carnahan. Accordingly, Applicant respectfully requests allowance of Claim 1.

Amended independent Claims 5, 8 and 11 recite methods for testing a modem, wherein first and alternate communication links are formed between a modem testing device and a computer having a modem, the communication links providing separate paths to the computer. Therefore, amended independent Claims 5, 8 and 11 are

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believed to be patentable for reasons similar to those set forth above in the discussion of independent Claim 1 and for the different aspects recited therein.

Claims 3-4 and 12-15 depend from independent Claim 1 and are believed to be patentable for the additional features recited therein.

Claim 16 depends from independent Claim 5 and is believed to be patentable for the additional features recited therein.

Claim 19 depends from independent Claim 8 and is believed to be patentable for the additional features recited therein.

Claims 22 and 23 depend from independent Claim 11 and are believed to be patentable for the additional features recited therein.

Request for Telephone Interview

Pursuant to M.P.E.P. § 713.01, in order to expedite prosecution of this application, Applicant's undersigned attorney of record hereby formally requests a telephone interview with the Examiner as soon as the Examiner has considered the effect of the arguments presented above. Applicant's attorney can be reached at (949) 721-2998 or at the general office number listed below.

Conclusion

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

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Respectfully submitted,

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